

Applicants' Response to the
Restriction Requirement

The Examiner has determined that there allegedly are two inventions in this application, and has required restriction of the application to one of those inventions. The two alleged inventions are:

I. Claims 1-78 and 151-165, drawn to aiding a user to view a program within an adaptive browsing feature, classified in class 725, subclass 46; and

II. Claims 79-150 and 166-177 drawn to aiding a user to view a program within an adaptive flipping feature, classified in class 725, subclass 48.

Applicants hereby elect, with traverse, the invention of Group I (claims 1-78 and 151-165) for prosecution in this application. This application is expressly without waiver of applicants' right to pursue the remaining inventions in one or more divisional applications.

Applicants' Response to the
Election-of-Invention Requirement

The Examiner contends that there are allegedly two inventions disclosed in the application (i.e., the adaptive browsing feature and the adaptive flipping feature) and has required applicants to elect one of these inventions for initial substantive prosecution. The Examiner states the following as reasons for restriction:

[The inventions] are distinct from each other if they are shown to be separately used. In the

instant case, invention I has separate utility such as providing an adaptive web browsing to aid users in program selection. Invention II has separate utility such as providing an adaptive web surfing to aid users in program selection

Office Action, ¶ 3.

"There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent ... or distinct as claimed; and (B) There must be a serious burden on the Examiner if restriction is required ..." (MPEP § 803).

The two alleged inventions are neither independent nor distinct

Applicants traverse the election-of-invention requirement to the extent that they believe that Group II (claims 79-150 and 166-177) is not "independent" or "distinct" from Group I (claims 1-79 and 151-165) within the definitions set forth in MPEP § 802.01. In particular, "[t]he term 'independent' means that ... the two or more subjects disclosed ... are unconnected in design, operation, or effect ..." (MPEP § 802.01). In the instant case, Group I is directed towards aiding a user in identifying programs of interest based on attributes of monitored television programming viewed by the user. Similarly, Group II is directed towards aiding a user in identifying programs of interest based on attributes of monitored television programming viewed by the user. Thus, it is clear that the

subject matter of Group I and Group II are connected in design, operation, and effect.

"The term distinct means that the two or more subjects as disclosed are related, ... but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER" (MPEP § 802.01)(emphasis in original). The Examiner relies on MPEP § 806.05(d) for showing distinctness. MPEP § 806.05(d) states that "[t]wo or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown separately usable, are usually distinct from each other." MPEP § 806.05(d) further states that "[t]he Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination."

To meet this burden, the Examiner contends that Group I has separate utility in "adaptive web browsing" and that Group II has separate utility in "adaptive web surfing." Applicants respectfully submit that the distinction between the terms "web browsing" and "web surfing" (with respect to their vernacular usage) is ambiguous at best, and more likely, nonexistent. The two terms are so related and non-distinct that by classifying Group I and Group II using these terms, it is apparent that the respective claims are non-distinct as well.

Thus, applicants respectfully submit that the restriction requirement is improper because the two alleged inventions have not been shown to be either independent or distinct.

There is no serious burden on the Examiner requiring restriction of the two alleged inventions

Applicants traverse the election-of-invention requirement to the extent that they believe that there is no serious burden on the Examiner requiring restriction of the two alleged inventions (MPEP § 803).

The Examiner contends that the alleged inventions "have acquired a separate status in the art as shown by their different classification ..." (Office Action, ¶ 4). According to MPEP § 808.02, "the examiner ... must show appropriate explanation of one of the following:

(A) Separate classification ... (B) A separate status in the art when [the alleged inventions] are classifiable together ... (C) A different field of search." Applicants respectfully submit that it is not clear on which of these reasons the Examiner basis his restriction. Applicants further respectfully submit that the Examiner has not provided "appropriate explanation."

Assuming that the Examiner intended to base the contention on reason (A) above, applicants respectfully submit that the two alleged inventions should not be

separately classified. For example, the Examiner classified Group I in class 725, subclass 46, which relates to creating a configuration based on, for example, viewing history. This classification, however, is also applicable to the claims of Group II. Both groups relate to suggesting programs that are identified based on a viewer's viewing history.

Moreover, the Examiner classified Group II in class 725, subclass 48, which relates to integrating or displaying program guide data from plural sources of such data. This classification, however, is also applicable to the claims of Group I. Both groups relate to displaying program listings that may have been acquired from any of a plurality of sources.

With regard to reason (B) above, applicants respectfully submit that Group I and Group II do not have separate status in the art even if they were classifiable together. According to MPEP § 808.02, separate status may be shown by citing patent that evidence the separate status and a separate field of search. However, the Examiner has not relied upon any such patent.

With regard to reason (C) above, applicants respectfully submit that Group I and Group II do not necessitate a separate field of search. The nature of the adaptive browsing feature of Group I and the adaptive

flipping feature of Group II is such that the field of search is not separate.

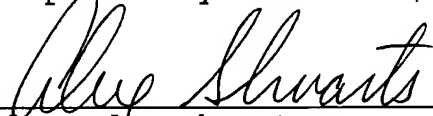
Thus, applicants submit that the restriction requirement is improper because there is no serious burden on the Examiner requiring restriction of the two alleged inventions.

Conclusion

In view of the foregoing, applicants respectfully request that the restriction requirement be removed. Applicants understand that if the restriction requirement is removed, the non-elected invention will be rejoined to the application.

An early and favorable action is respectfully requested.

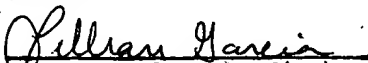
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